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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,523	01/21/2004	Koji Hagiya	2185-0716P	1106

2292 7590 11/15/2004
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EXAMINER

NGUYEN, CAM N

ART UNIT PAPER NUMBER

1754

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,523

Applicant(s)

HAGIYA ET AL.

Examiner

Cam N Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 30, 2004 (an amendment/response).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicants' remarks and amendments, filed on August 30, 2004, have been carefully considered. Claims 1-6 have been amended. New claims 7 & 8 have been added.

Claims 1-8 are now pending in this application and under consideration.

Claim Rejections - 35 USC § 102(b)/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krabetz et al., "hereinafter Krabetz", (US Pat. 4,925,823).

Krabetz discloses an oxidation catalyst having a general formula

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$\text{Mo}_{12}\text{P}_a\text{W}_b\text{Sb}_c\text{As}_d\text{Cu}_e\text{X}_f\text{O}_x$, wherein X is Nb, Fe, Mn, or a mixture thereof, and wherein a is 0.5-2, b is 0.5-3, c is 0.2 to 1.5, d is 0.01-0.5, e is 0.01-0.5 and f is 0-1.0, etc. (see col. 7, claim 1).

Recitation of product-by-process in the claims is noted. While the catalyst of the reference is not made by the same process, the catalyst made is the same as the claimed catalyst since it contains the same metal components. It is considered the process steps as being claimed have no bearing on the patentability of the claimed catalyst, but the catalyst limitations itself. See In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 173 USPQ 688, 688 (CCPA 1977); In re Fessman, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP 2113*.

It is noted that specific tungsten and molybdenum metal compounds being claimed are considered process limitations.

Krabetz discloses an oxidation catalyst containing the claimed metals, thus anticipates the claims.

Response to Applicants' Arguments

4. Applicants' amendment/response filed in August 30, 2004 has been fully considered, but not deemed persuasive for the following reasons.

First, applicants urged, that "the elements used in the invention oxidation catalyst compositions have been limited in the instantly amended claims. In contrast to the present invention, the catalyst of Krabetz et al. requires Sb, and As or Cu, or both, also as essential elements, etc." (applicants' response page 6,

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middle paragraph). This is noted but not found persuasive because: (1) The instant claims 1 & 2 require a tungsten metal compound or molybdenum metal compound of tungsten or molybdenum, respectively, and an element of Group IIIb, IVb, Vb or VIb. Since the elements P, Sb, and As belonging to the Group Vb elements of the periodic table, and that the oxidation catalyst of Krabetz includes these elements, the instant claims are anticipated by the Krabetz reference. (2) Applicants amended claims 1 & 2 including the "consisting essentially of" language is noted. The "consisting essentially of" language while limits the claims to specified ingredients or components and those that do not affect the basic and novel characteristics of a composition. See *Ex parte Davis et al.*, 80 USPQ 448. However, when applicants contend that modifying components in the reference composition are excluded by the recitation of the "consisting essentially of", applicants have the burden of showing the basic a novel characteristics of their composition, i.e., a showing that the introduction of these components would materially change the characteristics of applicants' composition. (3) The instant claims are called for "a catalyst", and not "a process of preparing a catalyst", it is considered the instant claims are product-by-process limitations. It has been held that the patentability of the product and its method of production are separately determined, thus, the process limitations in the instant claims have no bearing on the patentability of the claimed catalyst. See the case laws cited in the rejection above.

Second, applicants urged, that "the presently claimed compositions, which lack essential elements taught by Krabetz et al., are useful for the oxidation of

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olefin compounds. In contrast, the catalyst of Krabetz et al. are suitable for the oxidation of acrolein to acrylic acid, etc.” (applicants’ response page 6, last paragraph). This is also noted, but not found persuasive because: (1) the instant claims are broadly recite “an oxidation catalyst”. There is no specific use limitation, such as “useful for the oxidation of acrolein to acrylic acid”^{is} being claimed. (2) Even if there were intended use limitations in the catalyst claims claimed, according to *In re Pearson* and *In re Thrau*, the claimed oxidation catalyst composition would not be patentably distinct from the catalyst composition of the prior art. *In re Pearson 181, USPQ 641* states that [“It is well settled that terms merely setting forth intended use for, or a properly inherent in, an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art.”] *In re Thrau, 57 USPQ 324* states that [“It is contrary to spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions where uses consists merely in employment of compositions; patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him.”]

It is the Examiner’s position to conclude that Applicants’ claimed oxidation catalyst is anticipated by the Krabetz et al. reference, thus the rejection is maintained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Claims 1-8 are pending in the application. Claims 1-8 are rejected. No claims are allowed.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (571) 272-1357. The examiner can normally be reached on M-F from 9:30 am. to 6:00 pm.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number (571) 272-1700.

Nguyen/cnn 

November 12, 2004

CAM N. NGUYEN
PRIMARY EXAMINER

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